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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT G. ARSENAULT, STEPHEN P. DULAC,  
TAM T. LEMINH, and LAURA J. O'DONNELL

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Appeal 2009-000,959  
Application 09/677,691  
Technology Center 2400

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Decided:<sup>1</sup> May 29, 2009

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Before MAHSHID D. SAADAT, ROBERT E. NAPPI, and MARC S.  
HOFF, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is a decision on appeal under 35 U.S.C. § 6(b) of the final rejection of claims 1 through 7, 9 through 15, 17 through 23, 25 through 31, 33 through 39, 41 through 47, and 49.

We reverse the Examiner's rejection of these claims and enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

## INVENTION

The invention is directed towards a system for providing a program guide to subscribers of a satellite television broadcasting system which makes use of more than one satellite. The system maps a portion of the programming guide from a first and second satellite to the signal from one of the satellites (i.e. one of the satellite's signals includes the program guide for program material broadcast from the other satellite). See page 4 of Appellants' Specification. Claim 1 is representative of the invention and reproduced below:

1. In a broadcasting system having a first service network broadcasting a first signal having a first set of program material and first program guide information describing at least a portion of said first set of program material, and a second service network broadcasting a second signal having a second set of program material and second program guide information describing at least a portion of said second set of program material, wherein the first broadcast signal and the second broadcast signal each include service channels uniquely described by a service channel identifier, a method of providing at least a portion of the second program guide information to a receiving station receiving the first signal, comprising the steps of:  
mapping at least a portion of the first program guide information to a first service channel of the first broadcast signal;  
mapping at least a portion of the second program guide information to a second service channel of the first broadcast signal,

wherein the second service channel is logically offset from the first service channel; and  
transmitting the first signal to the receiving station;  
wherein the second program guide information includes data identifying the service network transmitting the second program guide information and wherein the first program guide information and the second program guide information is merged according to a comparison between the data and a receiver station configuration value.

### REJECTION AT ISSUE

The Examiner has rejected claims 1 through 7, 9 through 15, 17 through 23, 25 through 31, 33 through 39, 41 through 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over Eyer.

### ISSUE

Appellants contend on pages 14 through 18 of the Brief<sup>2</sup>, that the Examiner's rejection under 35 U.S.C. § 103(a) is in error.<sup>3</sup> Appellants argue that Eyer does not teach the claimed data identifying the service network transmitting the second program guide information. Appellants argue that, contrary to the Examiner's finding, Eyer's "region ID" does not meet this limitation.

Thus, Appellants' contentions present us with the issue of: have Appellants shown that the Examiner erred in finding that Eyer teaches or suggests the claimed feature of a service network transmitting a portion of

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<sup>2</sup> Throughout this opinion we refer to the Brief filed March 2, 2007 and the Reply Brief, filed August 28, 2007.

<sup>3</sup> We note that on pages 7 through 14 of the Brief, Appellants present arguments directed to a rejection under 35 U.S.C. § 102(e) which is not before us. Accordingly, we have not considered these arguments.

program guide information associated with another service network as claimed?

#### FINDINGS OF FACT

1. Eyer teaches a system for delivering interactive programming guide to a television receiver which receives global and local content via a satellite network and a cable network. Abstract.
2. The Interactive programming guide data for both local and global programming (television content) is received from many sources and provided to a satellite multiplexer. This multiplexer also receives a portion of the global programming. Eyer, col. 5, l. 54- col. 6, l. 5.
3. The Interactive programming guide and global programming is provided to the user's Interactive Receiver Decoder (IRD, item 140) decoder via satellite link from the satellite multiplexer. Col. 6, ll. 19-23.
4. The IRD can also receive programming (television content via a cable network). The IRD also filters the interactive programming guide to determine data related to channels the user receives and deletes unnecessary data. This filter makes use of configuration data that including a region ID. Col. 6, ll. 23-30, col. 6, l. 67- col. 7, l. 6, col. 8, ll. 57-67.
5. Eyer does not discuss the interactive programming guide being provided to the user by any medium other than the satellite link.

#### PRINCIPLES OF LAW

“A transitory, propagating signal . . . is not a 'process, machine, manufacture, or composition of matter.’ Those four categories define the

explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007) *reh’g en banc denied*, 515 F.3d 1361 (Fed. Cir. 2008), *cert. denied*, 129 S.Ct. 70 (2008).

“If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *Id.* at 1354.

### ANALYSIS

Appellants’ contentions have persuaded us that the Examiner’s rejection of 1 through 7, 9 through 15, 17 through 23, 25 through 31, 33 through 39, 41 through 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over Eyer is in error. Independent claim 1 recites in the preamble that there are two service networks each broadcasting a signal having program material and a program guide. Claim 1 further recites providing a portion of the second program guide (provided by second serviced network) to a station receiving the first signal including the step of mapping a portion of the second guide to a channel of the first signal (the signal from the first service network). Independent claims 9, 17, 33, and 49 contain limitations that recite a similar arrangement of two service networks, wherein one broadcasts a portion of the guide associated with programming on the other network. Independent claims 25<sup>4</sup> and 41 recite a complementary arrangement where a signal is received that includes

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<sup>4</sup> We note that claim 25 is drawn to a system or apparatus yet includes the statement “comprising the steps” which is a term usually associated with

portions of a program guide from two service networks. Thus, the scope of all of the independent claims includes that there are two service networks each broadcasting a signal with a guide, and that for one of them (the first) the signal also includes a portion of the guide for the other service network.

The Examiner, in responding to Appellants' arguments, finds that Eyer's teaching of a system that provides an interactive program guide to users who receive content by satellite and cable meets the claimed system. Answer 5. The Examiner equates a national or global network that provides a signal with the first signal and a regional or local network that provides a signal with the claimed second signal.

We disagree with the Examiner's findings. As discussed above, the independent claims recite two service networks that provide content and service guide information where the signal from one of the networks provides a portion of the service guide for programming on the other network. Initially, we note that it is not clear from the Examiner's rejection whether the Examiner is equating the claimed service networks with the cable provider and satellite signal provider (items 140 and 100), or if the Examiner is considering the service networks to be the source of the programming content provided to the cable provider and satellite provider. In either scenario, we do not find that the reference teaches or suggests the claimed invention. Eyer teaches that the satellite provider generates an interactive programming guide (IPG) which is provided to the user along with programming content via satellite link (link from item 110 to 120 and received in item 130). Fact 3. The receiver decoder also receives

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method claims. We consider this to be a minor typographical error and that the claim should read "comprising."

programming content from a cable provider (link from item 140 to item 150). Fact 4. Eyer teaches that the IPG contains codes which allow the receiver decoder to discard guide information that does not apply to the user. Fact 4. Eyer does not discuss or suggest that the cable provider provides a programming guide to either the user or the satellite broadcaster (items 100 and 110). Fact 5. Thus, if the Examiner interpreted the cable provider as a broadcast network, then we consider the rejection to be in error, as there is no teaching or suggestion that the cable provider provides IPG data in addition to programming content. If the Examiner interpreted the service networks to be the source of the programming content provided to the cable provider (e.g., local television station), we do not find that Eyer teaches or suggests that such service networks provide IPG information for other service networks as claimed. Accordingly, we do not find that Eyer teaches or suggests all of the limitations of the independent claims. Therefore, we will not sustain the Examiner's rejection of claims 1 through 7, 9 through 15, 17 through 23, 25 through 31, 33 through 39, 41 through 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over Eyer.

#### NEW GROUNDS OF REJECTION UNDER 37 C.F.R. § 41.50(b)

Under 37 C.F.R. § 41.50(b), we enter a new ground of rejection against claim 49 under 35 U.S.C. § 101. Claim 49 recites "In a broadcasting system .... a signal embodied in a carrier wave, the signal produced by performing the method steps of: ..." Thus, claim 49 recites a signal embodied as a carrier wave which is produced by performing certain steps. A signal is not within one of the four categories of patentable subject matter as defined under 35 U.S.C. § 101. *Nuijten*, 500 F.3d at 1357. Accordingly,



we now reject claim 49 as being drawn to subject matter that is not eligible for patent protection under 35 U.S.C. § 101.

**ORDER**

The Examiner's rejection of claims 1 through 7, 9 through 15, 17 through 23, 25 through 31, 33 through 39, 41 through 47, and 49 is reversed.

We enter a new rejection of claim 49 under 35 U.S.C. § 101.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). This section provides that “[a] new ground of rejection... shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED  
37 C.F.R. 41.50(b)

ELD

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